

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application Serial No.09/925,519
Confirmation No.4981
Filing Date8/10/2001
Inventorship.....Luca Chiarabini
AppellantHewlett-Packard Company
Group Art Unit3625
ExaminerJames Zurita
Attorney's Docket No.HP1-0585US
Title: Method And Apparatus For Automated On-Line Printing Service

REPLY BRIEF

To: Commissioner for Patents
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In response to the Examiner's Answer dated September 10, 2007, in connection with Appellant's Amended Appeal Brief filed May 16, 2007, a Reply Brief pursuant to 37 C.F.R. §41.41 is hereby submitted. Appellant respectfully requests favorable consideration.

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

Claims 10 and 28-30 stand rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent Pub. No. 2003/0140315 to Blumberg et al. (hereinafter "Blumberg").

Claim 27 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Blumberg in light of Official Notice.

Appellant notes that while claim 30 stands rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the enablement requirement, this issue is not raised on appeal.

REJECTIONS UNDER 35 U.S.C. §102(E)

In the Examiner's Answer, the Office has essentially restated the same rejections of claims 10 and 28-30 as provided in the Final Office Action of March 21, 2006. Appellant fully addressed these rejections in Appellant's Appeal Brief. In the interest of brevity, Appellant will not repeat Appellant's arguments from the Appeal Brief.

REJECTIONS UNDER 35 U.S.C. §103(A)

In the Examiner's Answer, the Office has also essentially restated the same rejections of claim 27 as provided in the Final Office Action of March 21, 2006. Appellant fully addressed these rejections in Appellant's Appeal Brief. In the

interest of brevity, Appellant will not repeat Appellant's arguments from the Appeal Brief.

However, Appellant also notes that in the Examiner's Answer, the Examiner appears to address an argument never made in Appellant's brief. Specifically, the Answer states that "Appellant's pre-KSR brief argues that there is no teaching[,] suggestion[,] or motivation to combine Blumberg with the prior art". Examiner's Answer of September 10, 2007, p. 5. The Examiner then proceeds to address this argument. Without commenting on the Examiner's statements, Appellant only points out that the Examiner appears to address arguments never raised by Appellant.

RESPONSE TO ARGUMENTS

Appellant respectfully reiterates all arguments in favor of allowance made in Appellant's previously-filed Appeal Brief. No admission or comment is made with respect to any assertions put forth within the Examiner's Answer not addressed herein.

Appellant further argues a few points, as follows, in view of the Examiner's Answer.

First, in the Answer on page 8, the Examiner states:

First, Appellant appears to contradict himself by admitting that Blumberg discloses finishing of printed items after the print items have been printed on sheet materials

Examiner's Answer at p. 8.

Appellant only notes that Appellant's brief does not take issue with printing generally as the above passage implies, but rather the brief submits that Blumberg fails to disclose the language of Appellant's claim 28. As discussed in the brief, Appellant respectfully submits that Blumberg has not been shown to disclose "wherein said act of electronically distributing [to at least one print service provider] is based on said at least one print service provider facility being capable of printing on said particular sheet material". (emphasis added).

Second, Appellant respectfully but strongly disagrees with at least one assertion made by the Examiner in his discussion of claim 29 on pages 8 and 9 of the Answer. Specifically, on page 9, the Examiner states the following:

- The Examiner also notes that Appellant contradicts himself and appears to agree with the Examiner's interpretation:

[Blumberg discloses]...printing eight-page booklets on a single large page, thereby minimizing the number of cuts to the virtual media sheet Brief, at 14

Examiner's Answer, p. 9.

It appears that the Examiner is referring to the following statements from Appellant's brief:

In making out a rejection of this claim, the Office states that Blumberg discloses all of the elements of this claim. **Specifically, the Office instructs Appellant to "[s]ee for example, references to paragraph 96. See also references to printing eight-page booklets on a single large page, thereby minimizing the number**

of cuts to the virtual media sheet.” (*Office Action of 01/03/06, p. 7-8*). Appellant traverses the rejection.

Appeal Brief of May 13, 2007, p. 13 (emphasis added).

Unfortunately, the Examiner appears to fail to take notice that this passage in Appellant's brief **quotes the arguments made by the Examiner in the Final Office Action of January 3, 2006.** As such, the assertion made by the Examiner in the Examiner's Answer (reproduced above) improperly imputes the Examiner's statement to Appellant.

In addition to noting this impropriety, Appellant also herein takes this space to again assert that Blumberg's "eight-page booklets" have not been shown to disclose Appellant's claim 29 for at least the reasons provided in Appellant's brief.

CONCLUSION

For at least the reasons provided above and in Appellant's brief, Appellant respectfully submits that the rejections set forth in the Final Office Action of January 3, 2006 in connection with the subject application should be reversed. Appellant respectfully requests favorable consideration of this Reply Brief.

Respectfully Submitted,

Dated: 2007/11/9

By: 

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